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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/276,253	03/25/99	MCCAY	M UTRC-57

RICHARD T REDANO  
ROSENBLATT & REDANO  
ONE GREENWAY PLAZA  
SUITE 500  
HOUSTON TX 77046

MMC2/0607

EXAMINER

VO, H

ART UNIT

PAPER NUMBER

2857

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DATE MAILED:

06/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/276,253

Applicant(s)

McCay et al.

Examiner

Hien Vo

Group Art Unit

2857



☒ Responsive to communication(s) filed on Mar 25, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Notice to Applicant(s)***

1. This application has been examined. Claims 1-20 are pending.
2. The prior art submitted on 03/25/99 has been considered as indicated on the enclosed copies of Form PTO-1449.

***Drawings***

3. The drawings are objected to under 37 CFR § 1.84 for the reasons set forth by the draftsman. See attached PTO-948 form for details. Correction is required.

Direct any inquiries concerning drawing review to the Drawing Review Branch (703) 305-8404.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

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on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-20 are rejected under 35 U.S.C. § **102(b)** as being anticipated by Honda (U.S. Patent No. 5,610,811).

With respect to claim 1, Honda discloses surgical instrument file system including marking hospital instruments with an optically scannable mark (see at least col. 1, lines 13-16), reading and representing marks into a computer database (see e.g. col. 1, lines 17-20), using the instrument for hospital procedures and entering information into the database that identifies which instruments have been used in each hospital procedure (see e.g. col. 1, lines 9-20).

With respect to claim 2, Honda discloses that the marking is performed with a laser, an ink jet, or an acid etch (see e.g. col. 3, lines 63-67).

With respect to claim 3, Honda discloses an optical scanner electrically coupled to the database (see e.g. col. 5, lines 19-36).

With respect to claim 4, Honda discloses that the optical scanner is portable (see e.g. Fig. 2).

With respect to claim 5, Honda discloses that the scannable marks comprises information indicative of the part number of each instrument (see e.g. col. 6, lines 52-64).

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With respect to claims 6-9, Honda discloses a maintenance schedule for each instrument (see e.g. Fig. 7, col. 5, lines 58-65 and col. 6, lines 44-51).

With respect to claims 10-12, Honda discloses that the database is a relational database, accessible at multiple data entry, retrieval locations and computer network (see e.g. Figs. 3-11 and cols. 5-6).

With respect to claims 13-20, the limitations of these claims have been noted in the rejection as applied to claim 1-12 above. Therefore, they are considered rejected as set forth above.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Honda (U.S. Patent No. 5,463,213) discloses a code mark reader.

Honda (U.S. Patent No. 5,610,810) discloses a surgical instrument file system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Hien Vo, whose telephone number is (703)308-5253. The examiner can normally be reached on Monday-Friday from 9:30 AM-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff, can be reached on (703)308-1677.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-7382 (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to Crystal Plaza 4, Arlington, VA.,  
Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703)308-0956.

  
MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800

**HIEN VO**  
June 02, 2000